

DOCKET NO.: FCI-2699/4450G
Application No.: 09/916,491
Office Action Dated: March 3, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS/ARGUMENTS

Claims 46-53 stand rejected in the present application. Claims 46, 47, 49, 50 and 52 have been amended. Claims 48, 51 and 53 have been canceled. Upon entry of the present response, claims 46, 47, 49, 50 and 52 will remain pending.

Claim Objections and Obviousness-Type Double Patenting

Claims 46 and 47 were objected to by the office action for certain informalities. Claims 46 and 47 have been amended as per the Examiner's suggestion. Accordingly, applicants respectfully request withdrawal of the objections to claims 46 and 47.

Claims 46, 49 and 52 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 17-19 of U.S. Patent No. 6,058,018 to Gerrits *et al.* ("Gerrits"). In response to the obviousness-type double patenting rejection, applicants submit herewith the attached terminal disclaimer with the appropriate fee, disclaiming the part of any patent granted on the pending rejected claims which would extend beyond the full statutory term of Gerrits. Also, included with the present response is a copy of the change of name documentation, filed with the USPTO on August 4, 2003, evidencing that Berg Technology, Inc. has changed its name to the present application owner FCI Americas Technology Inc., and thus the terminal disclaimer is proper.

Accordingly, applicants respectfully request withdrawal of the rejection of claims 46, 49 and 52 under the judicially-created doctrine of obvious-type double patenting.

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Claim Rejection under 35 U.S.C. § 112

Claims 49-53 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, with regard to claim 49, the office action suggests that the phrase "electronic card assembly deflecting less than the PCMCIA standard during a PCMCIA bend test which applies a force of approximately 20N" is unclear allegedly because applicants have failed to disclose the PCMCIA standard value of the PCMCIA bend test. In addition, with regard to claim 52, the office action suggests that the phrase "card displacing less than the PCMCIA standard during a fingernail test which applies a force of more than approximately 100N" is unclear allegedly because applicants have failed to disclose the PCMCIA standard during a fingernail test.

Applicants respectfully ask the Examiner to recognize that the PCMCIA standard is mentioned throughout the prior art references and throughout the present specification, particularly on page 11, lines 11-13 and Tables I through III. In light of the discussion of the PCMCIA standard in the present specification with reference to the tests that were conducted, as discussed with reference to Tables I through III, applicants note that one skilled in the art readily would understand the PCMCIA standard referred to. Accordingly, applicants respectfully request withdrawal of the rejection of claims 49-53 under 35 U.S.C. § 112, second paragraph.

Claim Rejections under 35 U.S.C. § 103

Independent claims 46, 50 and 52 have been amended to include the limitations originally found in dependent claims 48, 51 and 53, respectively. Also, claims 48, 51 and 53

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have been canceled. As amended, the independent claims 46, 50 and 52 of the present invention disclose an electronic card assembly that does not include a printed circuit board during the relevant testing.

Claims 46-53 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 5,574,628 to Persia *et al.* ("Persia") in view of U.S. Patent No. 5,497,297 to Kilmer *et al.* ("Kilmer"). In particular, with regard to claims 48, 51 and 53, the office action acknowledges that "Persia as modified by Kilmer does not specifically teach that the printed circuit board is not included during the deformation test." (*Office action dated March 3, 2003* at p. 6). However, the office action allegedly overcomes this limitation in the teaching of Persia and Kilmer by contending that "[d]ue to the fact that the electronic card assembly include a shield and a printed circuit board therein, it would have been obvious extension to an artisan of ordinary skill in the art . . . to provide a deformation of the frame kit or shield with and without the electronic card assembly in order to obtain the exact deformation characteristic of the frame shield with and without the printed circuit board . . . as an obvious expedient." (*Id.*). In other words, the office action contends that it would have been obvious to test the electronic card assembly without a printed circuit board, even though it admits that this feature is not taught in either Persia or Kilmer. Applicant respectfully disagrees.

As amended, the pending independent claims recite that the electronic card assembly is tested without a printed circuit board. Although the Examiner may generally assume as a practical matter that end product performance testing of a completely assembled electronic card is known to one skilled in the art because the printed circuit board/frame shield combination is subjected to stresses during shipping and use, the prior art does not teach or suggest testing an electronic card assembly without the added inherent strengthening

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characteristics of the rigid internal printed circuit board. Therefore, it is improper to assume that such a configuration is required or expected during the wholly distinct testing process.

Also, based on the foregoing, applicants respectfully assert that the amendments to claims 46, 50 and 52 remove all other possible obviousness rejections with regard to Persia in view of Kilmer. Accordingly, applicants respectfully request withdrawal of the rejection of claims 46, 47, 49, 50 and 52 under 35 U.S.C. § 103(a) over Persia in view of Kilmer.

CONCLUSION

In view of the foregoing remarks, the present application is believed to be in condition for allowance, and a Notice of Allowability is respectfully solicited. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney Vincent J. Roccia at (215) 564-8946 to discuss resolution of any remaining issues.

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Vincent J. Roccia
Registration No. 43,887

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439